

Application No.: 09/894,917

Docket No.: 30004783-1

REMARKS

Reconsideration and allowance of the subject application in view of the foregoing amendments and the following remarks is respectfully requested.

Claims 42-99 are pending. Claims 42, 44, 46, 49, 60, 67, 70, 73, and 99 have been amended to clarify claim language and avoid rejections based on 35 U.S.C. 112, second paragraph.

Withdrawal of the previous rejection of claims 42-99 in view of Hawkins et al. (U.S. Patent 6,009,458, the '458 patent) as a result of Applicants' arguments presented in the Appeal Brief of September 16, 2005 is noted.

Rejections under 35 U.S.C. §112, second paragraph**The term "short-range" are not indefinite**

The rejection of claims 42, 60, 94, and 99 as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicants regard as the invention is hereby traversed. Compliance with 35 U.S.C. 112, second paragraph, involves a determination of whether the claim apprises one of ordinary skill in the art of the claim scope, i.e., whether the claims set out and circumscribe a particular subject matter with a reasonable degree of clarity and particularity. The fact that claim language, including terms of degree, may not be precise, does not automatically render the claim indefinite under 35 U.S.C. 112, second paragraph. Seattle Box Co., v. Industrial Crating & Packing, Inc., 731 F.2d 818, 221 USPQ 568 (Fed. Cir. 1984).

In the present claims (specifically, claims 42, 60, 94, and 99), the portable entertainment machine is recited to comprise a short-range wireless transceiver device. The specification describes that the short-range wireless capability includes one such as "a Bluetooth™ network or an IrDA (Infra Red Data Association) network." Instant specification at page 2, lines 8-9. Applicants believe that a person of ordinary skill in the art would be able to understand with a reasonable degree of clarity and particularity the meaning of the term "short-range" in view of the recited comparison with a Bluetooth™

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and IrDA network. Clearly a person of ordinary skill in the art would have an understanding of the distances involved with a Bluetooth™ and/or an IrDA network.

Further, the "short-range" wireless link is described as being used, "when two machines are within range of each other." Instant specification at page 2, line 11. The "short-range" aspect is further highlighted in that it provides an, "additional interest factor especially when the machine users are on the move, since the ability to swap will depend upon what other machines come into range of the user's machine." Instant specification at page 2, lines 12-14. Thus, the portable entertainment machine includes a "short range" wireless transceiver able to communicate with another machine "when the user's machine comes within range of another similar machine." Instant specification at page 4, lines 15-16. The specification further sets out that two of the machines, "can only exchange digital objects when the respective transceivers 7 are within range of each other." Instant specification at page 13, lines 4-5.

Somewhat similar to the present case, the phrase "an effective amount" has been held to be definite. The proper test is whether or not one skilled in the art could determine specific values for the amount based on the disclosure. See In re Mattison, 509 F.2d 563, 184 USPQ 484 (CCPA 1975). Applicants believe a person of ordinary skill in the art would be able to determine specific values for the range.

Based on each of the foregoing reasons, the term "short-range" is believed to be sufficiently definite that it sets out and circumscribes the particular subject matter with a reasonable degree of clarity and particularity to a person of ordinary skill in the art. The Patent and Trademark Office (PTO) is requested to identify more specifically the lack of definiteness and/or suggest acceptable alternative language. Withdrawal of the rejection of claims 42, 60, 94, and 99 is requested.

The terms "more detailed representation" are not Indefinite

The rejection of claims 43 and 63 as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicants regard as the invention is hereby traversed. Compliance with 35 U.S.C. 112, second paragraph, involves a determination of whether the claim apprises one of ordinary skill in the art of the claim scope, i.e., whether the claims set out and circumscribe a particular subject matter with a reasonable degree of clarity and particularity. The fact that claim language, including

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terms of degree, may not be precise, does not automatically render the claim indefinite under 35 U.S.C. 112, second paragraph. Seattle Box Co., v. Industrial Crating & Packing, Inc., 731 F.2d 818, 221 USPQ 568 (Fed. Cir. 1984).

Similar to the above discussion regarding the asserted indefiniteness of "short range," applicants believe that a person of ordinary skill in the art would be able to understand with a reasonable degree of clarity and particularity the meaning of the term and determine what is intended by the claim language based on the disclosure in the instant specification, e.g., "[b]y operation of one of the control buttons 4 an enlarged image of a data object selected from selected article window 8 can be displayed," and "[w]hen only an icon is displayed in selected article window display 8 a fuller image of the data object may be chosen to be shown in main display 11." Instant specification at page 10, lines 23-24 and page 11, lines 16-18.

Based on each of the foregoing reasons, the terms "more detailed representation" are believed to be sufficiently definite that they set out and circumscribe the particular subject matter with a reasonable degree of clarity and particularity to a person of ordinary skill in the art. The Patent and Trademark Office (PTO) is requested to identify more specifically the lack of definiteness and/or suggest acceptable alternative language. Withdrawal of the rejection of claims 43 and 63 is requested.

Claims 44, 46, 67, and 70

The rejection of claims 44, 46, 67, and 70 as being Indefinite is believed overcome in view of the foregoing amendments and withdrawal of the rejection is respectfully requested.

Claims 49, 57, 73, and 81

The rejection of claims 49 and 73 as being indefinite is believed overcome in view of the foregoing amendments and the rejection of claims 57, and 81 is not understood as the claims do not include the term "potential," and withdrawal of the rejection is respectfully requested.

The terms "limited length of time" are not Indefinite

The rejection of claims 51 and 75 as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicants regard as the invention

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is hereby traversed. Compliance with 35 U.S.C. 112, second paragraph, involves a determination of whether the claim apprises one of ordinary skill in the art of the claim scope, i.e., whether the claims set out and circumscribe a particular subject matter with a reasonable degree of clarity and particularity. The fact that claim language, including terms of degree, may not be precise, does not automatically render the claim indefinite under 35 U.S.C. 112, second paragraph. Seattle Box Co., v. Industrial Crating & Packing, Inc., 731 F.2d 818, 221 USPQ 568 (Fed. Cir. 1984).

Similar to the above discussion regarding the asserted indefiniteness of "short range" and "more detailed representation," applicants believe that a person of ordinary skill in the art would be able to understand with a reasonable degree of clarity and particularity the meaning of the term and determine what is intended by the claim language based on the disclosure in the instant specification, e.g., "the restrictive condition may be a time limit on the use of the digital object." Instant specification at page 5, lines 5-6. That is, the use of the digital object may be not unlimited as specified.

Based on the foregoing reason, the terms "limited length of time" is believed to be sufficiently definite that they set out and circumscribe the particular subject matter with a reasonable degree of clarity and particularity to a person of ordinary skill in the art. The Patent and Trademark Office (PTO) is requested to identify more specifically the lack of definiteness and/or suggest acceptable alternative language. Withdrawal of the rejection of claims 51 and 75 is requested.

Claims 42-63, 65, 67-86, 88-90, 92, and 94-99 are not anticipated by Hawkins et al. (U.S. Patent 6,009,458)

The rejection of claims 42-63, 65, 67-86, 88-90, 92, and 94-99 as being anticipated by Hawkins et al. is hereby traversed. A rejection based on 35 U.S.C. §102 requires every element of the claim to be included in the reference, either directly or inherently. Hawkins fails to include all elements of the claimed subject matter and withdrawal of the rejection is respectfully requested.

Hawkins fails to disclose a proximity-based trading product as claimed in the present claimed subject matter. Hawkins discloses swapping of playing objects; however, Hawkins is silent on the point of trading between portable entertainment

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machines comprising a short-range wireless transceiver device capable of transmitting and receiving signals solely to and from the transceiver of another portable entertainment device which is within range of the portable entertainment machine as claimed in the present claimed subject matter.

Hawkins describes use over "wireless networks (cellular, satellite)" and in "a peer-to-peer model." Hawkins at column 5, lines 34-35 and lines 57-58. However, this is not dispositive of the issue as Hawkins fails to disclose short-range wireless transactions between portable entertainment machine transceivers which are capable of communicating with transceivers of other portable entertainment machines. A peer-to-peer model fails to satisfy the claim limitation as, with respect to a client/server model, the peer-to-peer model indicates only that the nodes comprising the peer-to-peer model function as both "clients" and "servers" with respect to other nodes. That is, peer-to-peer does not state whether the nodes are able to communicate solely with other nodes within range of each other.

Further, Hawkins indicates the use of a network for communication between the two client systems. Hawkins at column 5, lines 42 and 60 and FIGs. 1 and 2. Hawkins does not disclose the client systems communicating using wireless transceivers which are within range of each other. To the contrary, Hawkins describes the use of a network to enable communication between the client systems. The network includes "direct electrical connections, point-to-point dial-up connections, intranets, internets, the Internet, wireless networks (cellular, satellite), etc." None of the provided examples include a disclosure of wireless transceiver to wireless transceiver within range communication, rather each of the examples includes a network connecting the communicating client systems or a direct electrical connection between the client systems.

Based on each of the foregoing reasons, amended, and non-amended, claim 42 is patentable over Hawkins and withdrawal of the rejection is respectfully requested.

Claims 43-59 depend, either directly or indirectly, from claim 42, include further limitations, and are patentable over Hawkins for at least the reasons advanced above with respect to claim 42. The rejection of claims 43-59 should be withdrawn.

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Further specifically with respect to claims 47 and 52, Hawkins fails to disclose any information concerning the range between the client systems and the master user database. For at least this additional reason, the rejection of claims 47 and 52 should be withdrawn.

Amended, and non-amended, claim 60 is patentable for at least reasons similar to those advanced above with respect to claim 42 and withdrawal of the rejection is respectfully requested.

Claims 61-63, 65, 67-86, 88-90, 92, and 94-98, depend, either directly or indirectly, from claim 60, include further limitations, and are patentable over Hawkins for at least the reasons advanced above with respect to claim 60. The rejection of claims 61-63, 65, 67-86, 88-90, 92, and 94-98 should be withdrawn.

Further specifically with respect to claims 71 and 76, Hawkins fails to disclose any information concerning the range between the client systems and the master user database. For at least this additional reason, the rejection of claims 71 and 76 should be withdrawn.

Amended, and non-amended, claim 99 is patentable for at least reasons similar to those advanced above with respect to claim 42 and withdrawal of the rejection is respectfully requested.

Claims 64 and 66 are not obvious in view of Hawkins

The rejection of claims 64 and 66 under 35 U.S.C. 103(a) as being unpatentable over Hawkins is hereby traversed. As described above, Hawkins fails to anticipate at least amended, and non-amended, claim 60 from which claims 64 and 66 depend and the PTO has failed to cure the above-noted deficiencies of Hawkins. Based on the foregoing, withdrawal of the rejection is respectfully requested.

Claims 87, 91, and 93 are not obvious in view of Hawkins

The rejection of claims 87, 91, and 93 under 35 U.S.C. 103(a) as being unpatentable over Hawkins is hereby traversed. As described above, Hawkins fails to anticipate at least amended, and non-amended, claim 60 from which claims 87, 91, and 93 indirectly depend and the PTO has failed to cure the above-noted deficiencies of Hawkins. Based on the foregoing, withdrawal of the rejection is respectfully requested.

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Conclusion

All objections and rejections having been addressed, it is respectfully submitted that the present application should be in condition for allowance and a Notice to that effect is earnestly solicited.

To the extent necessary, a petition for an extension of time under 37 C.F.R. 1.136 is hereby made. Please charge any shortage in fees due in connection with the filing of this paper, including extension of time fees, to Deposit Account 07-1337 and please credit any excess fees to such deposit account.

Respectfully submitted,

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